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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: SINGH et al. Examiner: Yao, K.

Serial No.: 08/741,265 Group Art Unit: 2664

Filed: October 30, 1996 Docket No.: New: 8X8S.004US01  
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Title: INTERNET TELEPHONY ARRANGEMENT AND METHOD

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this communication is being deposited, in triplicate, in the United States Postal Service, as first class mail, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on July 12, 2001.

By: *Erin M. Nichols*  
Erin M. Nichols

APPEAL BRIEF

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

This is an Appeal Brief submitted pursuant to 37 CFR §1.192 for the above-referenced patent application, in which claims 1-12 and 16-23 stand rejected.

**I. Real Party in Interest**

The real party in interest is Netergy Networks, Inc., having a place of business at 2445 Mission College Boulevard, Santa Clara, CA 95054. The above referenced patent application is assigned to Netergy Networks, Inc. (formerly 8 X 8, Inc.).

**II. Related Appeals and Interferences**

There are no related appeals or interferences.

**III. Status of Claims**

Claims 1, 4 and 16-23 stand rejected under 35 U.S.C. §102(e) as being anticipated by *White et al.* (U.S. Patent No. 6,069,890); claims 2, 3, 5, 6 and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *White et al.* in view of *Kuthyar et al.* (U.S. 5,909,431),

*Shinohara et al.* (US 5,351,237) and *O'Neil et al.* (US 5,963,547); claims 7 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *White et al.* in view of *Kalavade et al.* (U.S. 5,961,599); and claims 8, 9, and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *White et al.* in view of *Kuthyar et al.*, *Shinohara et al.* and *O'Neil et al.*, and further in view of *Kalavade et al.* Applicant hereby cancels claim 16.

#### **IV. Status of Amendments**

A Preliminary Amendment was filed on October 20, 1997 prior to the examination of the patent application. A first Office Action was mailed on May 4, 1999 and in response, an Office Action Response and Amendment as well as a Declaration under 37 CFR 1.131 was filed on August 4, 1999. A second Office Action was mailed on October 26, 1999, and a response to the second Office Action was filed on December 10, 1999. On February 28, 2000, a third Office Action was mailed, and a response was filed on May 30, 2000. A fourth Office Action was mailed on August 14, 2000, and a response was filed on November 14, 2000. On February 13, 2001, a Final Office Action was mailed, and an Office Action Response After Final was filed on April 4, 2001. A Notice of Appeal was filed on May 14, 2001, with the incorrect mailing date of April 4, 2001 in the Certificate Under 37 CFR 1.8 affidavit. A Notice of Errata explaining the discrepancy was filed on May 25, 2001. Also, an Advisory Action was mailed on May 18, 2001. The current claims under appeal may be found in the appendix.

#### **V. Summary of Invention**

In accordance with a particular embodiment of the invention, the interface includes an input coupled to the telephone to receive audio information and two output ports configured to be respectively coupled to the standard switched telephone communications network and the Internet communications network. The interface further includes a processing unit which couples the audio information received from the telephone to the first output port in response to an indication that the telephonic communication is to be performed using the standard switched telephone communications network. The processing unit further processes the audio information received from the telephone in accordance with standard Internet transfer protocols and couples the processed audio information to the second output port in response to an indication that the telephonic communication is to be performed using the Internet communications network for

transmission over the Internet using the standard Internet transfer protocols. The processing unit must designate a telephonic communication addressee to the audio information.

## **VI. Issues for Review**

**ISSUE 1:** Are the §102(e) and §103(a) rejections of claims 1-12 and 16-23 proper when the asserted references, taken alone or in combination, fail to teach the claimed invention including the limitations requiring that the audio information being analyzed designate a “telephonic communication addressee” or that “the audio information being analyzed for the determination is also sent down the selected path to establish the communication”?

**ISSUE 2:** Are the §103(a) prior art rejections proper when neither the ‘547 *O’Neil* patent (filed 9/18/1996) nor the ‘599 *Kalavade* patent (filed 10/15/1997) is prior art, in view of the §1.131 *Martin* Declaration establishing a priority date of not later than September 4, 1996?

## **VII. Grouping of Claims**

For purposes of this appeal, claims 1-12 and 17-23 define claim group 1, claims 2, 3, 5, 6 and 12 define claim group 2, and claims 7-11 define claim group 3. The claims as now presented do not stand or fall together.

## **VIII. Argument**

The claim groups are appropriate. Claim group 2 is separately patentable over the prior art and over the other claim groups of the present invention because claim group 2 is directed to subject matter that is not necessarily present in the prior art and the other claim groups and because this subject matter is said to be allegedly present in an asserted combination of references that includes the ‘547 *O’Neil* patent. Claim group 3 is separately patentable over the prior art and over the other claim groups of the present invention because it is directed to subject matter that is not necessarily present in the prior art and the other claim groups and because this subject matter is said to be allegedly present in an asserted combination of references that includes the ‘599 *Kalavade* patent. Appellants submit that neither the ‘547 *O’Neil* patent nor the ‘599 *Kalavade* patent is “prior” art.

**ISSUE 1:** The §102(e) and §103(a) rejections of claims 1-12 and 16-23 cannot stand when the asserted references, taken alone or in combination, fail to teach the claimed invention including the limitations requiring that the audio information being analyzed designate a “telephonic communication addressee” or that “the audio information being analyzed for the determination is also sent down the selected path to establish the communication”.

Appellants contend that the §102(e) rejection based upon the ‘890 patent is improper for failing to teach all aspects and limitations of the claimed invention and that, in this regard, the Final Office Action fails to present a *prima facie* case by alleging such correspondence. In the Final Office Action dated February 13, 2001, the Examiner relies on the ‘890 patent which “discloses a system for providing telephone type services”, but does not include for example, limitations requiring that the audio information being analyzed for the determination also designate a “telephonic communication addressee.” The Final Office Action alleges that these claim limitations including the required designation of a “telephonic communication addressee” are present in the ‘890 patent but does not indicate where. There is no allegation in paragraph 2 of the Final Office Action of the ‘890 patent including the limitation of requiring that the audio information being analyzed for the determination also designate a “telephonic communication addressee.” Thus, without such prior art correspondence being alleged or otherwise apparent in the cited prior art, no *prima facie* case of anticipation is present.

Furthermore, according to the claimed invention, the audio information is analyzed to determine whether to send the audio information to a standard telephonic communication path or to an Internet communication path. In this regard, the claim limitations require that the audio information being analyzed for the determination is also sent down the selected path to establish the communication. In contrast, the White ‘890 patent teaches use of a special prefix (“\*82”) that is neither used to designate a telephonic communication addressee, nor is sent down the selected path to establish the communication. The ‘890 patent fails to teach all limitations of the claimed invention and in relying on the use of a special prefix (“\*82”) teaches away from the claimed invention. Again, the Final Office Action alleges that these claim limitations including that “the audio information being analyzed for the determination is also sent down the

selected path to establish the communication” are present in the ‘890 patent but does not indicate where. There is no allegation in paragraph 2 of the Final Office Action of the ‘890 patent including the limitation of requiring that “the audio information being analyzed for the determination is also sent down the selected path to establish the communication.” None of the other asserted references overcomes this deficiency in the alleged correspondence.

In view of the above comments, the §103(a) rejection is also improper and cannot stand. The combination of asserted references fails to teach all limitations of the claimed invention. Each of the asserted combinations includes the ‘890 patent which does not include teachings that correspond to the limitations of the claimed invention as discussed above. The Final Office Action does not even allege that, in combination, the asserted references disclose these limitations of the claimed invention. Therefore, the §103(a) rejection must fail.

**ISSUE 2: The §103(a) prior art rejections are not proper when neither the ‘547 O’Neil patent (filed 9/18/96) nor the ‘599 Kalavade patent (filed 10/15/97) is prior art, in view of the §1.131 Martin Declaration establishing a priority date of not later than September 4, 1996.**

Appellants contend that the §103(a) rejections are improper since the ‘547 and ‘599 patents are not prior art. Appellants evidenced possession of the claimed invention prior to the filing dates of both the ‘547 and the ‘599 patents. The ‘547 patent was filed on September 18, 1996, and the ‘599 patent was filed on October 15, 1997. The §1.131 Martin Declaration (filed with the August 4, 1999 Office Action Response) established that the claimed invention has an effective priority date not later than September 4, 1996. In the Advisory Action the Examiner states that the application is not in condition for allowance because “the cited prior art can still be applied to the rejected claims” but does not allege how this is possible. In view of the §1.131 Martin Declaration and the MPEP, Appellants submit that the Examiner’s statement cannot stand.

To remove any possible questions regarding correspondence between the rejected claims and the §1.131 evidence, Appellants relied on MPEP §715.02 and §715.03, citing various authoritative decisions to explain that the priority entitlement issue turns on whether the inventor

had "possession of the invention (*i.e.*, the basic inventive concept)," and, assuming any differences would have been obvious, the "differences between the claimed invention and the showing" were unimportant. M.P.E.P 715.02 further states that a §103(a) rejection based on a combination of references may be overcome "by showing completion of the invention by applicant prior to the effective date of any of the references." Since each of the §103(a) rejections relies on at least one of the '547 or '599 patents, the §1.131 Martin Declaration is sufficient to overcome each of the prior art §103(a) rejections.

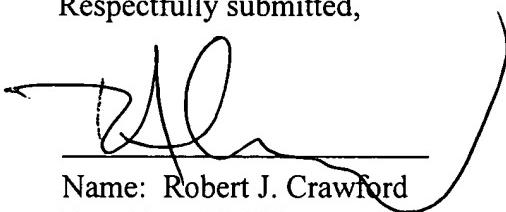
Moreover, Appellants note that the filing date of the related provisional application behind the '599 patent is after the effective priority date of the instant application. The filing date of the provisional application for the '599 patent is October 15, 1996, more than a month after the effective priority date of September 4, 1996 of the claimed invention. Thus, the §1.131 Martin Declaration clearly eliminates both the '547 and the '599 patents as prior art and sufficiently overcomes all of the §103(a) rejections.

## **IX. Conclusion**

Appellants respectfully request reversal of the rejection as applied to the appealed claims and allowance of the application.

Respectfully submitted,

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## APPENDIX OF APPEALED CLAIMS

1. An arrangement for providing telephonic communication which may be selectively transmitted via the Internet using standard Internet protocols, comprising:
  - a telephone; and
  - an interface unit coupled to the telephone and configured and arranged to receive audio information designating a telephonic communication addressee, the interface unit including
    - a first output port configured to be coupled to a standard switched telephone communications network,
    - a second output port configured to be coupled to an Internet communications network, and
    - a processing unit configured and arranged to analyze the audio information and, in response to the analysis, to determine whether the audio information received from the telephone is to be coupled to the first output port to establish a standard telephonic communication using the standard switched telephone communications network, or if the audio information is to be processed in accordance with the standard Internet transfer protocols and coupled to the second output port to establish an Internet communication using the Internet communications network to communicate the processed audio information in accordance with the standard Internet transfer protocols.
2. An arrangement as recited in claim 1, wherein the standard Internet transfer protocols include a standard gatekeeper protocol for handling gatekeeper signaling, a standard Internet call protocol for handling Internet call signaling and a standard end-to-end protocol for handling end-to-end control.
3. An arrangement as recited in claim 2, wherein the standard gatekeeper protocol uses an RAS standard protocol, the standard Internet call protocol uses a Q.931 standard protocol and the standard end-to-end protocol uses an H.245 standard control protocol.

4. An arrangement as recited in claim 1, wherein the standard Internet transfer protocols include a standard packetization protocol to packetize a stream of audio information.
5. An arrangement as recited in claim 4, wherein the standard packetization protocol uses a standard real-time transfer protocol (RTP).
6. An arrangement as recited in claim 3, wherein the standard Internet transfer protocols include a standard real-time transfer protocol (RTP) to packetize a stream of audio information.
7. An arrangement as recited in claim 4, wherein the standard Internet transfer protocols include a standard quality-of-service protocol for gathering quality-of-service statistics of packetized information delivered to a receiving device.
8. An arrangement as recited in claim 5, wherein the standard Internet transfer protocols include a standard quality-of-service protocol for gathering quality-of service statistics regarding packetized information communicated over the Internet.
9. An arrangement as recited in claim 8, wherein the standard quality-of service protocol uses standard real-time transfer control protocol (RTCP).
10. An arrangement as recited in claim 7, further comprising a monitoring unit provided to monitor the quality-of-service statistics and to adaptively control a rate at which audio information is transferred over the Internet.
11. An arrangement as recited in claim 9, further comprising a monitoring unit provided to monitor the RTCP information and to adaptively control a rate at which audio information is transferred over the Internet.
12. A method of providing telephonic communication using an Internet communications channel, the method comprising the steps of:

providing a first communications device, coupled to a standard switched telephone network for normal telephonic communication and to an Internet connection coupled to the Internet, the first communications device including an interface device provided to selectively couple an output of the first communications device to one of the standard switched telephone network and the Internet connection, the interface device being adapted to automatically determine, in response to data information designating a communication addressee, whether the output is to be selectively coupled to at least one of: the standard switched telephone network and the Internet connection;

providing a second communication device coupled to the Internet;

initiating a call using the first communication device to the second communication device using by establishing an initial Q.931 protocol;

establishing far end control of the second communication device by the first communication device in accordance with an H.245 protocol;

performing gatekeeper signaling in the first communication device accordance with an RAS protocol; and

packetizing audio information of the telephonic communication for transfer over the Internet using a standard real-time transfer protocol (RTP).

17. A method for providing telephonic communication that may be selectively transmitted via the Internet using standard Internet protocols, the method comprising:

providing an interface unit having a memory and adapted to receive telephonic communication in response to user intervention and to communicate the telephonic communication via at least one of: a first output coupled to a standard switched telephone network and a second output coupled to an Internet communications network;

providing a telephone device communicatively coupled to the interface unit;

generating audio information, that designates a communication addressee, at the telephone and sending the information to the interface unit;

analyzing the audio information and therein automatically determining, at the interface unit, whether the audio information received from the telephone is to be coupled to the first or second output; and

responsive to the determination, coupling the telephone via the interface unit to at least one of the standard switched telephone network and the Internet communications network.

18. The method of claim 17, wherein automatically determining whether the audio information is to be coupled to the first or second output is responsive to comparing a DTMF code received as part of the audio information to a variable stored in memory at the interface and is without further user intervention.

19. The method of claim 17, wherein automatically determining whether the audio information is to be coupled to the first or second output is responsive to detecting a DTMF code received as part of the audio information that represents the number for a local Internet access provider and is without further user intervention.

20. The method of claim 17, wherein automatically determining whether the audio information is to be coupled to the first or second output is responsive to comparing a DTMF code received as part of the audio information to a telephone number stored in memory at the interface and is without further user intervention.

21. The arrangement of claim 1, wherein the interface unit further comprises a memory, and wherein the processing unit is adapted to automatically determine whether the audio information is to be coupled to the first or second output by comparing a DTMF code received as part of the audio information to a variable stored in memory at the interface, without further audio information.

22. The arrangement of claim 1, wherein the processing unit is adapted to automatically determine whether the audio information is to be coupled to the first or second output by detecting if a DTMF code received as part of the audio information represents the number for a local Internet access provider, without further audio information.

23. The arrangement of claim 1, wherein the interface unit further comprises a memory, and wherein the processing unit is adapted to automatically determine whether the audio information

is to be coupled to the first or second output by comparing a DTMF code received as part of the audio information to a telephone number stored in memory at the interface, without further audio information.